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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,592	11/21/2003	Eva J. Tsai	Tsai	9389
7590	11/29/2004		EXAMINER	
John P. Sutton 2421 Pierce Street San Francisco, CA 94115			GONZALEZ, MADELINE	
			ART UNIT	PAPER NUMBER
			2859	

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/717,592

Applicant(s)

TSAI, EVA J.

Examiner

Madeline Gonzalez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

In response to applicant's amendment dated September 23, 2004

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 2 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Lustenberger (U.S. 1,510,285).

Lustenberger discloses a caliper, as shown in Fig. 1, having:

- two jaws 6, 8, appended from a beam 2 mounted transversely in relation to a cylinder B;
- wherein the caliper is capable of indicating distance between the jaws 6, 8, within the cylinder B, as shown in Fig. 3;
- characterized in that a stop 14 on each jaw 6, 8, is movable longitudinally between at least two limits to permit the jaws 6, 8, to measure distance at measuring points corresponding to the at least two limit positions perpendicular to and equidistant from the beam 2; and

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- wherein the caliper measures the inside diameter of a generally cylindrical surface along at least two points precisely the same distance from the end of the cylindrical surface.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3 and 4 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Lustenberger (U.S. 1,510,285).

Lustenberger discloses all the subject matter claimed above in paragraph 2 with the exception of the specific range of distance between the measuring points limited by the stops, and the specific distance from the stop closest to a measuring point.

With respect to the specific range of distance between the measuring points limited by the stops: Lustenberger discloses a caliper having stops 14. The stops 14 limit the measuring points certain distance. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to limit the distance between the measuring points in the range of 20mm to 40mm, since it has been held that where the general conditions of a claim are disclosed

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in the prior art, discovering the “optimum range” involves only routine skill in the art. See *In re Aller*, 105 USPQ 233. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the stops 14 disclosed by Lustenberger limiting the measuring points from 20mm to 40mm in order to obtain a measurement at two different points within the cylinder B. Furthermore, the distance between the measuring points will depend on the length of the jaws and the intended use of the caliper.

With respect to the specific distance from the stop closest to a measuring point: Lustenberger discloses a caliper having movable stops 14 and the stops are spaced at predetermined distances from a measuring point. To choose at least 20 mm distance from the stop to the closest measuring point, is only considered to be the “ optimum ” value of distance from the stop to the closest measuring point, as stated above, that a person having ordinary skill in the art would have been able to determine using routine experimentation based, among other things, on the desired accuracy and since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. See *In re Boesch*, 205 USPQ 215 (CCPA 1980). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to position the stop closest to a measuring point, disclosed by Lustenberger, at a distance of at least 20mm since that would be a preferred distance based on experimentation and the intended use of the caliper.

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5. Claim 5 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Lustenberger (U.S. 1,510,285) in view of Rogler (U.S. 5,565,501).

Lustenberger discloses a device for measuring the inside diameter of an object B having:

- a fixed jaw 6 with a point for measuring the maximum diameter at a point at one location along the friction surface of the object B;
- a movable jaw 8 with a point for measuring the maximum diameter at the same distance from the edge of the friction surface; and
- stops 14 movable longitudinally along the friction surface to keep the two opposed points the same distance along the friction surface of the object B.

Lustenberger lacks the specific use of the device, i.e., to measure the inside diameter of a brake drum.

With respect to the specific use of the device, i.e., to measure the inside diameter of a brake drum: Rogler teaches the use of a caliper, as shown in Fig. 3, for measuring the inside diameter of a brake drum. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the caliper disclosed by Lustenberger by making the jaws suitable for measuring the inside diameter of a brake drum as taught by Rogler, in order to make accurate measurements of the inside diameter of a brake drum and since the caliper disclosed by Lustenberger can be used to measure dimensions of any cylindrical body.

Response to Arguments

6. Applicant's arguments with respect to claims 1-5 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ginggen discloses an instrument having stops 11 and 12. Usan discloses a gage having stops 6 and 15.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeline Gonzalez whose telephone number is (571) 272-2243.

The examiner can normally be reached on Monday-Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MG



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